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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/186,342	11/04/1998	DARRELL C. CONKLIN	97-64	1674

7590                    03/26/2003

ZYMOGENETICS INC.  
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[REDACTED] EXAMINER

SPECTOR, LORRAINE

ART UNIT	PAPER NUMBER
1647	

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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EXAMINER

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DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

## OFFICE ACTION SUMMARY

- Responsive to communication(s) filed on 12/23/02.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- Claim(s) 2,3,5,11-14,16-21,22,24,26 is/are pending in the application.  
Of the above, claim(s) 11-14,16-21 is/are withdrawn from consideration.
- Claim(s) 26 is/are allowed.
- Claim(s) 2,3,5,22,24 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) 2,3,5,11-14,16-21,22,24,26 are subject to restriction or election requirement.

## Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been
- received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- Notice of Reference Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

**Part III: Detailed Office Action**

**Notice:** The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit **1647**.

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

10 Applicant's submission filed on 12/23/02 has been entered.

Claims 2, 3, 5, 22, 24 and 26 are under consideration.

**Objections and Rejections under 35 U.S.C. §§101 and 112:**

35 U.S.C. 101 reads as follows:

15 Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

20 The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

25 Claims 2, 3, 5, 22 and 24 remain rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific asserted utility or a well established utility.

Claims 2, 3, 5, 22 and 24 also remain rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility or a well

established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

These rejections are maintained for reasons set forth in paper number 14. The Whitmore declaration was fully considered in paper number 17. It remains that the specification as originally filed merely identified the nucleic acid in question as mapping to 3p21.2-p13 region, which is a large region in which genes can be found that are associated with cancer, neurosensory nonsyndromic recessive deafness, Larson syndrome, and non-ketotic type II hyperglycinemia, for example, all as set forth in paper number 14. Thus, the general assignment of the claimed nucleic acid sequences to that broad region does not support the currently urged utility of diagnosis of cancer, as numerous diseases were known to be associated with that region of chromosome, and in the absence of further information, e.g. that the nucleic acid actually maps to 13p14.2, as set forth in the Whitmore declaration, no specific utility could be attributed to the claimed nucleic acids. The Examiner maintains that the localization of the claimed nucleic acids to 13p14.2, as set forth in the Whitmore declaration, is part of the inventive process; without that knowledge, no specific utility could be attributed to the claimed nucleic acid. As utility must be present in readily available form at the time the application is filed, the Whitmore declaration is ineffective in establishing such, as it contains information that is not present in the specification as originally filed, and without which no specific utility can be attributed to the claimed nucleic acid.

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**Advisory Information:**

Claim 26 is allowable.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See

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Art Unit 1647

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MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Lorraine M. Spector, whose telephone number is (703) 308-1793. Dr. Spector can normally be reached Monday through Friday, 9:00 A.M. to 5:30 P.M.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Gary L. Kunz, at (703)308-4623.

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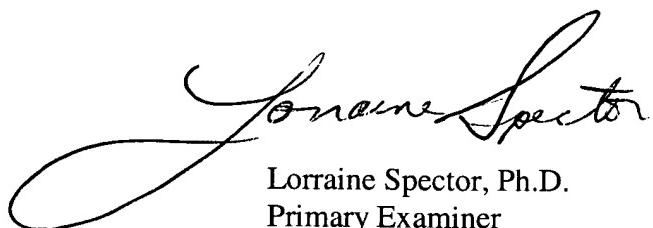
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at telephone number (703) 308-0196.

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Certain papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Official papers filed by fax should be directed to (703) 872-9306 (before final rejection) or (703)872-9307 (after final). Faxed draft or informal communications with the examiner should be directed to (703) 746-5228.

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Lorraine Spector

Lorraine Spector, Ph.D.  
Primary Examiner

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